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Carrier, Blackman & Associates
24101 Novi Road, Suite 100
Novi, MI 48375

In re Application of :
AKEDO, Jun, et al. :
U.S. Application No.: 10/070,104 : DECISION ON PETITION
PCT No.: PCT/JP00/07076 :
International Filing Date: 12 October 2000 :
Priority Date: 12 October 1999 :
Attorney's Docket No.: KNI-162-A :
For: COMPOSITE STRUCTURE AND METHOD :
AND APPARATUS FOR FORMING THE SAME :

This decision is issued in response to the "Response And Objection To Erroneous Notification Of Missing Requirements Under 35 U.S.C. 371" filed 05 June 2002, treated herein as a petition under 37 CFR 1.181 to confirm the filing on 19 February 2002 of declarations in compliance with 37 CFR 1.497. No petition fee is required.

BACKGROUND

On 12 October 2000, applicants filed international application PCT/JP00/07076 which claimed a priority date of 12 October 1999 and which designated the United States. On 19 April 2001, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB").

A Demand was filed with the International Preliminary Examining Authority electing the United States prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire thirty months from the priority date, i.e., 12 April 2002.

On 19 February 2002, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a translation of the international application into English, and two declarations. One of the declarations consisted of three pages and identified only one inventor, Jun AKEDO. The second declaration consisted of five pages and identified six inventors (Jun AKEDO was not named on this declaration). The seven inventors identified on these two declarations correspond to the seven inventors listed on the international application.

On 07 May 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than thirty months from the priority date were required. The Notification also informed applicants that the failure to

submit these materials within two months of the date of the Notification would result in abandonment of the application. The Notification specifically stated that the declarations filed on 19 February 2002 were defective because "all the inventors must be identified on all the declarations."

On 05 June 2002, applicants filed the "Response And Objection To Erroneous Notification Of Missing Requirements Under 35 U.S.C. 371" considered herein. Applicants' submission did not include a new declaration in compliance with 37 CFR 1.497 or the required surcharge. Rather, applicants argue that the declarations filed on 19 February 2002 were in compliance with 37 CFR 1.497, and that the revised declaration and surcharge are therefore not required.

DISCUSSION

37 CFR 1.497(a)(3) states that, among other information, the declaration must identify "each inventor and the country of citizenship of each inventor." Here, neither of the two declarations filed by applicants on 19 February 2002 satisfy this requirement. The three-page declaration identifies only one of the seven inventors (Jun AKEDO); the five-page declaration identifies only six of the seven inventors (it does not list Jun AKEDO). Accordingly, neither of these declarations complies with 37 CFR 1.497(a)(3). This defect was specifically identified in the Notification Of Missing Requirements mailed 07 May 2002 ("all the inventors must be identified on all the declarations").

Applicants argue that "[b]etween the two (2) declarations, all seven (7) inventors signatures were included" and that the declarations are therefore acceptable. This ignores the requirements of 37 CFR 1.497. It is not simply the signatures of all seven inventors that are required; what is required is the signature of all seven inventors **on declarations that comply with 37 CFR 1.497**. As discussed above, neither of the declarations filed here comply with 37 CFR 1.497, and specifically 37 CFR 1.497(a)(3). Applicants' argument that the 19 February 2002 submission satisfies 37 CFR 1.497 is therefore rejected.

It is noted that separate declarations may still be submitted, and each complete declaration submitted need not be signed by all the inventors; however, each submitted declaration must comply with the requirements of 37 CFR 1.497 (i.e., each declaration must list **all** of the seven inventors, even those who will not be signing that particular declaration).

CONCLUSION

Based on the above, applicants' petition is **DISMISSED** without prejudice. As stated in the Notification Of Missing Requirements mailed 07 May 2002, the declarations filed on 19 February 2002 are defective for failure to identify all the inventors.

Applicants' are given **ONE (1) MONTH** from the mail date of this decision to submit an oath or declaration in compliance with 37 CFR 1.497. This deadline is non-extendable; however, applicants may still obtain extensions of time under 37 CFR 1.136(a) with respect to the original deadline set forth in the Notification Of Missing Requirements mailed 07 May 2002.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



Richard Cole
PCT Legal Examiner
PCT Legal Office

RMR/RC:rmr



Richard M. Ross
PCT Petitions Attorney
PCT Legal Office

Telephone: (703) 308-6155

Facsimile: (703) 308-6459